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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,463	03/27/2001	William Skiles	SKILES 00.01	1835

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,463

Applicant(s)

SKILES, WILLIAM

Examiner

Ruth C Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,18,20-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-22 and 27-31 is/are allowed.
- 6) ☒ Claim(s) 17,18 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Willner (US 3,693,376).

A jewelry clasp (10) for releaseably holding a spherically shaped ornamental object (16) comprises a first semi-spherically shaped fixture (14), a second semi-spherically shaped fixture (14) and a spring member (12). The first semi-spherically shaped fixture comprises a truncated portion of a first spherical shell having a first inner concave surface (22), a first outer convex surface and a first edge (20) continuously joining the first inner concave surface to the first outer convex surface (Figs. 1-4). The second semi-spherically shaped fixture comprises a truncated portion of a second spherical shape having a second inner concave surface (22), a second outer convex

surface and a second edge (20) continuously joining the second inner concave surface to the second outer convex surface (Figs. 1-4). The spring member has semicircular shape (Figs. 1-3) and a first end (18) and a second end (18) where the first end is affixed to the first outer convex surface of the first fixture, interiorly of the first edge, and the second end is affixed to the second outer convex surface of the second fixture, interiorly of the second edge (Figs. 1-3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willner in view of Darling (US 3,693,376).

Willner discloses a clasp having all the limitations listed above for the rejection of claim 5 above. However, Darling teaches the use of buoyant putty (cellular material) for jewelry (C. 1, L. 26-39). The putty will prevent the piece of jewelry from sinking when immerse in water (C. 2, L. 5-13). Darling also teaches that the buoyant putty also protects objects being hold with the putty against damage (C. 10, L. 33-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a first cellular material disposed on the first inner surface of

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the first fixture and a second cellular material disposed on the second inner surface of the second fixture according to the teachings of Darling in the device of Willner. Doing so, will prevent the object being held from becoming damaged and will also provide buoyancy to the piece of jewelry if it were to become immerse in water.

Allowable Subject Matter

6. Claims 20-22 and 27-31 are allowed.

Response to Arguments

7. Applicant's arguments filed 26 August 2003 have been fully considered but they are not persuasive.

8. The first argument present by the Applicant is that Willner fails to disclose that the "fixtures are not semi-spherically shaped truncated portion of spherical shells having inner and outer concave surfaces". The Examiner fails to be persuaded by this argument. The fixtures disclosed by Willner are shaped like semi-spheres comprising a truncated portions of spherical shells because part of the outer surface of the fixture is part of a spherical shell, as illustrated in Attachment 1, and it is a truncated portion of the spherical shell. The Examiner can give any interpretation to these newly added limitations of the claims 17 and 23 since the Applicant fails to have support in his specifications for the limitations.

9. The Applicant also argues that the spring member is not fixed to the outer convex surface of the fixture. This argument fails to persuade. The Applicant brought up this argument in the amendment received on 22 July 2002. The Examiner addressed this argument in the Office Action mailed on 20 November 2002. This argument is not considered valid since the Applicant failed to address the Examiner's response in the subsequent amendment filed on 21 February 2003.

10. The Applicant also argues that the spring member disclosed by Willner is not affixed to the outer convex surface. Once again, the Examiner does not agree with this argument. The distal end of the outer convex surface is still part of the outer convex surface. Therefore, Willner does affix the spring member to the outer convex surface of the fixture. The amount of pressure exerted by spring onto the fixtures is not addressed in the claims therefore the arguments presented based on whether the location present by the applicant is better than the location disclosed by Willner does not have any relevancy with the respect to the claim subject matter.

11. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Applicant's clasp is in compression) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. In response to applicant's argument that the first and second cellular materials are provided to protect the surface of an ornamental object, the fact that applicant has

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recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

13. In response to applicant's argument that Darling is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art reference is in the field of applicants endeavor since Darling teaches the use of the cellular material in combination with a piece of jewelry as specified in lines 26-40 of column 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wecht (US 1,251,308), Kirshner (US 3,014,298), Johnson (US 4,195,492), Milawski (US 4,625,526), Santiago (US 5,433,090), Guio (US 5,440,791), Hanson (US 5,946,943) and German Patent Document DE 31 04 396 A1 are cited to show state of the art with respect to the use of clasps or clips having some of the features claimed under the current application. Miller (US 3,896,527) and Willoughby (US 4,536,924) are

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cited to show state of the art with respect to the use of a ratchet system to urge two sides of a clamp together.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C. Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.


Submissions of your responses by facsimile transmission are encouraged. Technology center 3600's facsimile number for before final communications is (703) 872-9326. Technology center 3600's facsimile number for after final communications is (703) 872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

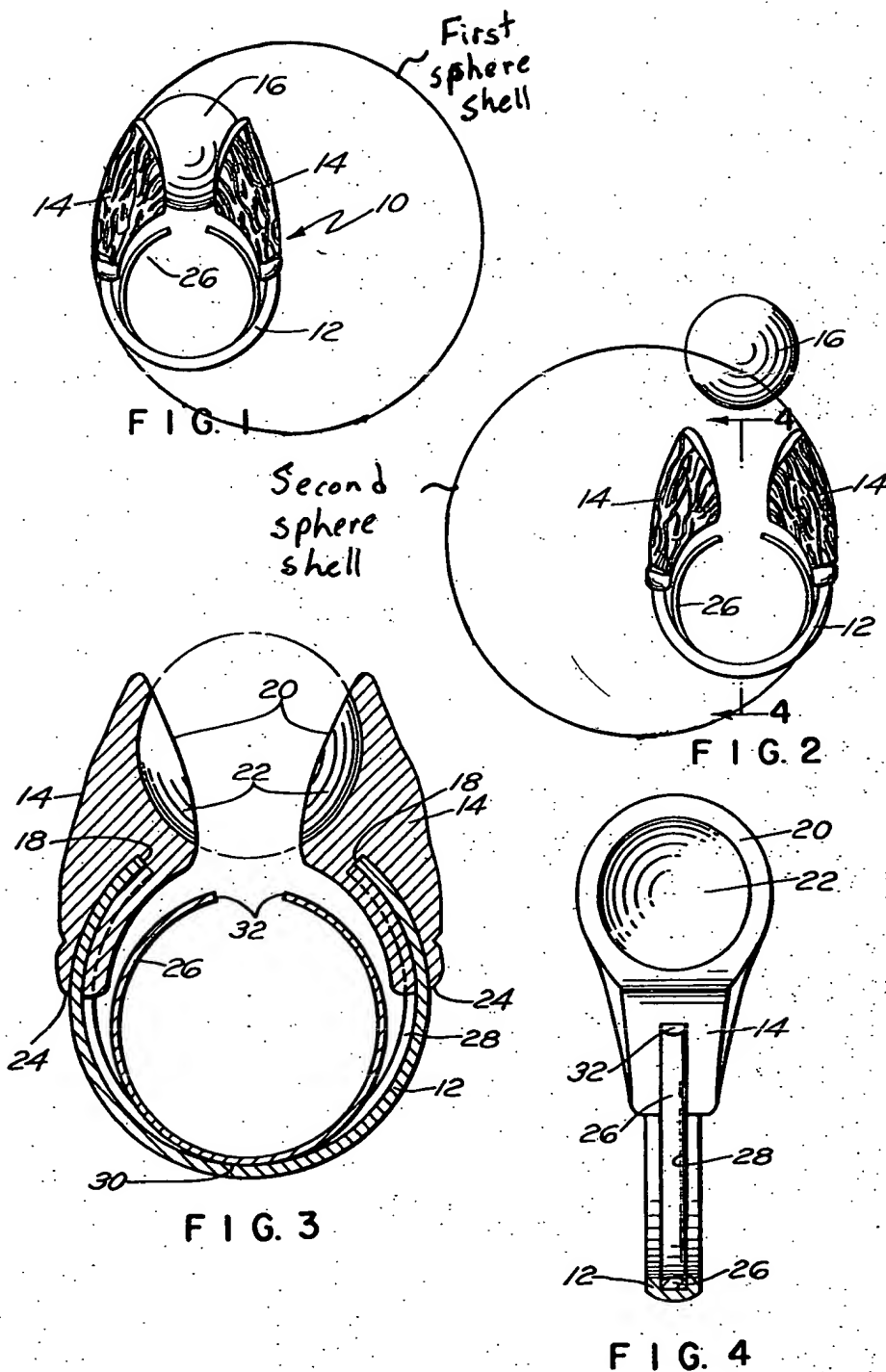
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October 17, 2003


ROBERT J. SANDY
PRIMARY EXAMINER

PATENTED SEP 26 1972

3,693,376



INVENTOR
ROBERT WILLNER
BY *Jalter & Michelson*
ATTORNEYS